1646

PTO/SB/17 (10-02)
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FEE TRANSMITTAL for FY 2003

Patent fees are subject to annual revision.

☐ Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT ($) 0.00

Complete if Known	
Application Number	09/911,346-Conf. #4955
Filing Date	July 24, 2001
First Named Inventor	Jian Ni
Examiner Name	P. Mertz
Group Art Unit	1646
Attorney Docket No.	PF199D2

METHOD OF PAYMENT *(check all that apply)*

☐ Check ☐ Credit Card ☐ Money Order ☐ Other ☐ None

☒ Deposit Account

Deposit Account Number: 08-3425

Deposit Account Name: Human Genome Sciences, Inc.

The Commissioner is hereby authorized to: *(check all that apply)*

☐ Charge fee(s) indicated below ☒ Credit any overpayments

☒ Charge any additional fee(s) during the pendency of this application

☐ Charge fee(s) indicated below, **except for the filing fee**

to the above-identified deposit account.

FEE CALCULATION

1. BASIC FILING FEE

Large Entity Fee Code	Large Entity Fee ($)	Small Entity Fee Code	Small Entity Fee ($)	Fee Description	Fee Paid
1001	740	2001	370	Utility filing fee	
1002	330	2002	165	Design filing fee	
1003	510	2003	255	Plant filing fee	
1004	740	2004	370	Reissue filing fee	
1005	160	2005	80	Provisional filing fee	

SUBTOTAL (1) ($) 0.00

2. EXTRA CLAIM FEES FOR UTILITY AND REISSUE

			Extra Claims		Fee from below		Fee Paid
Total Claims		-20** =		x		=	
Independent Claims		-3** =		x		=	
Multiple Dependent						=	

Large Entity Fee Code	Large Entity Fee ($)	Small Entity Fee Code	Small Entity Fee ($)	Fee Description
1202	18	2202	9	Claims in excess of 20
1201	84	2201	42	Independent claims in excess of 3
1203	280	2203	140	Multiple dependent claim, if not paid
1204	84	2204	42	** Reissue independent claims over original patent
1205	18	2205	9	** Reissue claims in excess of 20 and over original patent

SUBTOTAL (2) ($) 0.00

***or number previously paid, if greater; For Reissues, see above*

FEE CALCULATION (continued)

3. ADDITIONAL FEES

Large Entity Fee Code	Large Entity Fee ($)	Small Entity Fee Code	Small Entity Fee ($)	Fee Description	Fee Paid
1051	130	2051	65	Surcharge – late filing fee or oath	
1052	50	2052	25	Surcharge – late provisional filing fee or cover sheet.	
1053	130	1053	130	Non-English specification	
1812	2,520	1812	2,520	For filing a request for *ex parte* reexamination	
1804	920*	1804	920*	Requesting publication of SIR prior to Examiner action	
1805	1,840*	1805	1,840*	Requesting publication of SIR after Examiner action	
1251	110	2251	55	Extension for reply within first month	
1252	400	2252	200	Extension for reply within second month	
1253	920	2253	460	Extension for reply within third month	
1254	1,440	2254	720	Extension for reply within fourth month	
1255	1,960	2255	980	Extension for reply within fifth month	
1401	320	2401	160	Notice of Appeal	
1402	320	2402	160	Filing a brief in support of an appeal	
1403	280	2403	140	Request for oral hearing	
1451	1,510	1451	1,510	Petition to institute a public use proceeding	
1452	110	2452	55	Petition to revive – unavoidable	
1453	1,280	2453	640	Petition to revive - unintentional	
1501	1,280	2501	640	Utility issue fee (or reissue)	
1502	460	2502	230	Design issue fee	
1503	620	2503	310	Plant issue fee	
1460	130	1460	130	Petitions to the Commissioner	
1807	50	1807	50	Processing fee under 37 CFR 1.17(q)	
1806	180	1806	180	Submission of Information Disclosure Stmt	
8021	40	8021	40	Recording each patent assignment per property (times number of properties)	
1809	740	2809	370	Filing a submission after final rejection (37 CFR 1.129(a))	
1810	740	2810	370	For each additional invention to be examined (37CFR 1.129(b))	
1801	740	2801	370	Request for Continued Examination (RCE)	
1802	900	1802	900	Request for expedited examination of a design application	
Other fee (specify)					

*Reduced by Basic Filing Fee Paid SUBTOTAL (3) ($) 0.00

SUBMITTED BY				Complete *(if applicable)*	
Name (Print/Type)	Lin J. Hymel	*Registration No. (Attorney/Agent)*	45,414	*Telephone*	(301) 251-6015
Signature	Lin J. Hymel			*Date*	December 18, 2002

VIA HAND DELIVERY DECEMBER 18, 2002

#7
A.U.
1/15/03

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of: Ni et al.	Docket No.: PF199D2
Application No.: 09/911,346	Group Art Unit: 1646
Filed: July 24, 2001	Examiner: P. Mertz
For: Natural Killer Cell Enhancing Factor C	

PROVISIONAL ELECTION UNDER 37 C.F.R. § 1.143
WITH TRAVERSE

Commissioner for Patents
Washington, DC 20231

Dear Sir:

In response to the Office Action dated November 18, 2002, please consider the following provisional election with traverse. Applicants submit concurrently herewith: (a) a Fee Transmittal Sheet; (b) Marked-Up Copy of the Specification.

Provisional Election With Traverse

The Examiner has separated the pending claims into three different groups and has required an election under 35 U.S.C. § 121. *See*, Paper No. 6, page 2-3.

In order to be fully responsive, Applicants hereby provisionally elect, *with traverse*, the claims currently restricted to Group I (*i.e.*, claims 1-20, 29-52, 61-83, 92-115, and 124-127 drawn to antibodies).

With respect to separation of the claimed invention into three (3) groups and the reasons stated therefore, Applicants respectfully traverse. It was asserted in the restriction requirement that Groups I, II, and III claims represent distinct inventions because "the antibody of invention I as claimed can be used in the process of immunochromatography, to purify the NKEF C protein." *See*, Paper No. 6, page 2. It was then concluded:

> Having shown that these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classifications and recognized divergent subject matter as

> defined by MPEP.. § 808.02, the Examiner has *prima facie* shown a serious burden of search (see MPEP..§ 803)."

Id. at 2-3.

Applicants respectfully submit, however, that it would not entail a serious burden to examine all pending claims together, because a search of the antibody claims can be expected to provide all necessary information for the method of detecting and method of treatment claims. In particular, any publication that describes use of the claimed antibody in a method of detection or treatment must necessarily describe the antibody that is used therein. Therefore, any publications that might potentially disclose the presently claimed antibody would also encompass all publications disclosing methods of using that antibody (whether it be for detection or treatment purposes).

Accordingly, Applicants respectfully request that the restriction requirement under 35 U.S.C § 121 be reconsidered and withdrawn and the instant claims be examined in one application.

Request for Rejoinder of Product and Method of use Claims:

Furthermore, if the restriction requirement is maintained, Applicants request rejoinder of the claims of Groups I, II and III once the claims of Group I are found allowable. In light of the decisions in *In re Ochiai,* 71 F.3d 1565, 37 USPQ2d 1127 (Fed. Cir. 1995) and *In re Brouwer,* 77 F.3d 422, 37 USPQ 2d 1663 (Fed. Cir. 1996), a notice was published in the Official Gazette which set forth new guidelines for the treatment of product and process claims. *See* 1184 OG 86 (March 26, 1996). Specifically, the notice states that:

> in the case of an elected product claim, rejoinder will be permitted when a product claim is found allowable and the withdrawn process claim depends from or otherwise includes all the limitations of an allowed product claim.

Id. Accordingly, if claims of Group I are found allowable, Applicants respectfully request that the claims of Groups II and III be rejoined and examined for patentability. *See* also M.P.E.P. § 821.04. Applicants retain the right to petition from the restriction requirement under 37 C.F.R. § 1.144.